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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,882	11/20/2002	Ikuko Mikami		9142

38834 7590 01/19/2005

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EXAMINER

BOGART, MICHAEL G

ART UNIT PAPER NUMBER

3761

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,882

Applicant(s)

MIKAMI, IKUKO

Examiner

Michael G. Bogart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5 and 7-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5 and 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 8 is objected to because of the following informalities:

Claim 8 recites the limitation "said folded state" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim when the claim is read in its dependency from amended independent claim 12. It is noted that when the claim is read in its alternative dependency from claim 7, that antecedent basis for this limitation is provided.

In claim 8, line 2, after "elastic members", replace "is" with --are--.

Appropriate correction is suggested.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2-5 and 11 are rejected under 35 U.S.C. § 102(a) as being anticipated by Kim *et al.* (WO 00/09056).

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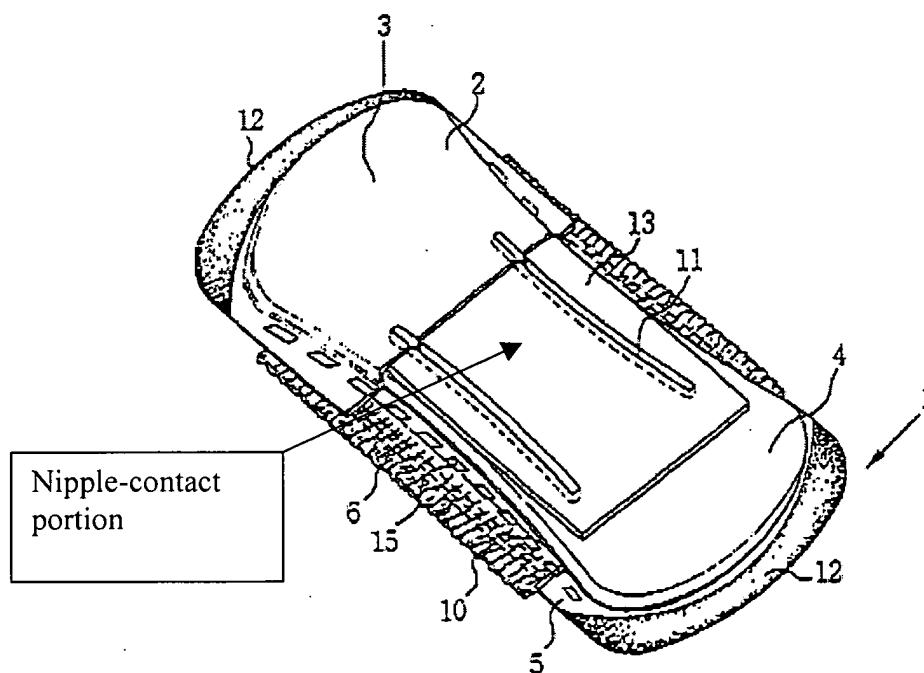
Regarding claim 11, Kim *et al.* teach a breast pad (1) comprising:

a main body having an edge portion including a first edge (8, 9) and a second edge (8, 9) opposed to the first edge (8, 9), the main body comprising a liquid-absorbing member (4);

a waterproof member (5) laminated outwardly on the liquid-absorbing member (4);

a first elastic member (10) disposed at the first edge (8, 9);

a second elastic member (10) disposed at the second edge (8, 9), and a pair of concave grooves (11) provided between the first elastic member (10) and the second elastic member (10), extending in an expansion direction of the first elastic member (10) and the second elastic member (10)(see figure 1, below).



Regarding the preamble's recitation that the invention is a "breast pad", if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than

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any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation").

In the present invention, applicant claims do not define any physical structure to distinguish the invention as a breast pad. Kim *et al.* teach an absorbent hygienic pad of generic application that meets all of the structural limitations of the claimed invention. Such a pad could serve, even if not ideally, to absorb fluid from a breast.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Regarding claim 2, Kim *et al.* teach concave grooves (11) that curve along said expansion direction of said elastic members (10)(the elastic members can expand in at least the longitudinal direction).

Regarding claim 3, Kim *et al.* teach concave grooves (11) that curve so as to protrude toward a central portion of said main body (figure 1).

Regarding claim 4, Kim *et al.* teaches a surface member (2) which comes in contact with a user's skin, said surface member (2) being inwardly disposed on said liquid-absorbing member (4) and a cushion member (13) disposed between said liquid-absorbing member (4) and said surface member (2).

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Regarding claim 5, Kim *et al.* teach that said surface member (2) is provided with said concave grooves (11) around a nipple-contact portion of said surface member (2)(see figure 2, above).

Claim 12 is rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Utility Model Application No. JP-U-H1-83005 (herein after '83005).

'83005 teaches a breast pad comprising:

a main body having an edge portion including a first edge and a second edge opposed to the first edge, the main body comprising:

a surface member (1), wherein the surface member (1) contacts a user's skin;

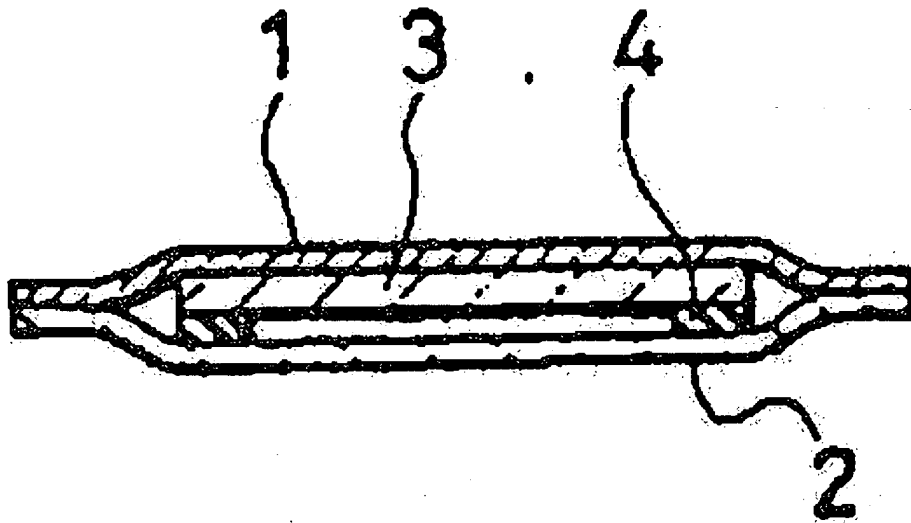
a liquid-absorbing member (3) laminated outwardly on the surface member (1);

a waterproof member (4) laminated outwardly on the liquid-absorbing member (3);

a first elastic member (4) disposed at the first edge; and

a second elastic member (4) disposed at the second edge, wherein the surface member (1) is extended to cover the liquid-absorbing member (3) at the edge portion (see translation of claims 1-3, provided by applicants on 08 Aug. 2001)(see figure 6, below).

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Claims 7-10 and 12 are rejected under 35 U.S.C. § 102(e) as being anticipated by Tanaka *et al.* (US 6,159,190 A).

Regarding claim 12, Tanaka *et al.* teach a breast pad comprising:

- a main body having an edge portion including a first edge (22) and a second edge (22) opposed to the first edge (22), the main body (1) comprising:
 - a surface member (23), wherein the surface member (23) contacts a user's skin;
 - a liquid-absorbing member (24) laminated outwardly on the surface member (23);
 - a waterproof member (32) laminated outwardly on the liquid-absorbing member (3);
 - a first elastic member (25) disposed at the first edge (22); and

Regarding claim 8, Tanaka *et al.* teach that said elastic members (25) are fixed between said liquid-absorbing member (24) and said folded surface member (23), or between said folded surface member (23) and said waterproof member (32), in a state in which said elastic members (25) sandwiched therebetween at the edge portion (22) of said main body, and wherein the elastic members (25) are not fixed to the main body at longitudinal ends thereof (see figure 2).

Regarding claim 9, Tanaka *et al.* teach that the liquid-absorbing member (24) is formed to be smaller than said waterproof member (32) and said surface member (23) at a region in which said elastic members (25) are terminated and wherein said elastic members (25) are not fixed to the waterproof member (32) and the surface member (23) at the region (figure 2).

Regarding claim 10, Tanaka *et al.* teach that approximately at an expanding center of said elastic member (25) on side edge portion (22) of said main body, said waterproof member (32) has an area not fixed to said liquid-absorbing member (24) and/or said surface member (23).

Response to Arguments

Applicant's arguments, see Remarks, filed 07 June 2004, with respect to the Objections to the specification and/or claims, and Rejections under 35 USC § 112 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of references to Tanaka *et al.*, JP-U-H1-83005 and Kim *et al.*

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

In the event the examiner is not available, the examiner's supervisor, Larry Schwartz may be reached at phone number (571) 272-4390. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-4933.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Bogart
13 January 2005



Larry I. Schwartz
Supervisory Patent Examiner
Group 3700